

UNITED STATE: DEPARTMENT OF COMMERCE Patent and Trademark Office Address: COMMISSIONER OF PATENTS AND TRADEMARKS Washington; D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENT	TOR .	ATTORNEY DOCKET NO.
08/347.7	80 11/30/9	4 BARTLEY	Т	A290C
·				EXAMINER
		10M1/0500	SPECTO	R, L
AMGEN IN	c	18M1/0530	ART UNIT	PAPER NUMBER
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M/S 10-2		EN CENTER		.,
	AVILLAND DRI OAKS CA 91	VE 320-1789	1812	
			DATE MAILED:	05/30/96
This is a communication COMMISSIONER OF	on from the examiner in PATENTS AND TRADE	charge of your application.		
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This application h	on hoon overstand	D	2/4/04	П
		Responsive to communication filed		
A shortened statutory	period for response to the	is action is set to expire 3n	nonth(s), days f	rom the date of this letter.
		se will cause the application to become	abandoned. 35 U.S.C. 133	
Part I THE FOLLOW	/ING ATTACHMENT(S)	ARE PART OF THIS ACTION:		
1. Notice of R	eferences Cited by Exa	niner, PTO-892. 2.	Notice of Draftsman's P	atent Drawing Review, PTO-948
3. Notice of A	rt Cited by Applicant, PT	O-1449. 4.		nt Application, PTO-152.
5. Information	on How to Effect Drawi	ng Changes, PTO-1474. 6.		
Part II SUMMARY	OF ACTION			
1 🔀 Claims	67-77			
Of the a	bove, claims		ar	e withdrawn from consideration.
2 Claims	1-66			_ have been cancelled.
4 🛛 Claims	67-77			are anowed.
		-		
6. Claims			are subject to restricti	on or election requirement.
7. This application	n has been filed with inf	ormal drawings under 37 C.F.R. 1.85 w	hich are acceptable for exan	nination purposes.
8. Formal drawing	gs are required in respo	nse to this Office action.		
9. The corrected	or substitute drawings h	ave been received on	. Under 37 (C.F.R. 1.84 these drawings
are accepta	able; Inot acceptable	see explanation or Notice of Draftsmar	n's Patent Drawing Review, F	PTO-948).
10. The proposed	additional or substitute :	sheet(s) of drawings, filed on	, has (have) been	☐ approved by the
examiner; 🔲	disapproved by the exam	niner (see explanation).		
11. The proposed	drawing correction, filed	, has been	☐approved; ☐ disapproved	(see explanation).
12. Acknowledgem	ent is made of the claim	for priority under 35 U.S.C. 119. The	certified copy has D been i	received not been received
D been filed in	parent application, seri	al no; filed on		
13. Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in				
accordance wit	h the practice under Ex	parte Quayle, 1935 C.D. 11; 453 O.G.	213.	
14. Other				

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

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- 1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
- I. Claims 1-12 and 28-30, drawn to MGDF polypeptides and corresponding composition, classified in Classes 530 and 424, subclasses 351 and 82.2 respectively
- II. Claims 13-24, drawn to polynucleotides that encode the MGDF polypeptides, vectors, cells and method of production of the protein, classified in Classes 435 and 536, subclass 69.5+ and 23.5 respectively.
- III. Claims 25-27 to antibodies, classified in Class 530, subclass 388.1+.
- VI. Claims 31-35, drawn to related methods of using the MGDF polypeptides, classified in Class 514, subclass 2+.
- V. Claims 36-44 and 57-66, drawn to modified/derivative forms of the MGDF polypeptides irrespective of the manner in which they are made, and their corresponding compositions, classified in Classes 530 and 424 subclasses 402+ and 85.2 respectively.
- VI. Claims 45-56, drawn to methods of making the modified/derivative forms of the MGDF polypeptides, classified in Class 530, subclass 402+.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the polypeptides can be made by a materially different process such as by the isolation and purification from nature using various isolation and purification protocols; or it

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could be produced synthetically. Furthermore, the protein and nucleic acid represent physically, functionally and patentably distinct products, which are not required one for the other.

Inventions of Group V and Group VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the modifies/derivative forms of the MGDF polypeptides can be made using different methods of chemical synthesis and chemical conjugation.

Inventions of Group I and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the polypeptides can be used in various therapeutic methods as shown by the claims or others therapeutic methods; and can be used in various diagnostic methods such as the use as a probe, in immunoaffinity purification, or bio-assays.

The inventions of Groups I, II, III and V are directed to distinct products. Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for different products, restriction is deemed to be proper because these products constitute physically, functionally, and patentably distinct products, which are not required one for the other. Furthermore, the two different methods of Groups IV and VI do not require one another or the products of several of the others Groups; and these methods require the use of physically

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and functionally distinct elements, components and steps.

- 2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter; the searches are not co-extensive; and there are different issues for the search and examination of each of the Groups, which would be unduly burdensome, therefore, restriction for examination purposes as indicated is proper.
- 3. A telephone call was made to Robert Cook from Elizabeth Kemmerer 11-30-95 to request an oral election to the above restriction requirement, but did not result in an election being made. Furthermore, applicants requested a written restriction requirement.
- 4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exm. Lorraine Spector whose telephone number is (703) 308-1793.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Note: Claim 14 is an improper multiple dependent claim which should be corrected.

GARRETTE O. DRAPEN SUPERVISORY PRIMARY EXAMINER GROUP 1800